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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,633	10/07/2005	Martyn Vincent Twigg	JMYT-348US	2150
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EXAMINER				
VANoy, TIMOTHY C				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
07/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,633

Applicant(s)

TWIGG ET AL.

Examiner

TIMOTHY C. VAN DYKE

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 11, 12, 14-17, 22-24, 28, 33-35, 40, 44 and 47-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 12, 14-17, 22-24, 28, 33-35, 40, 44 and 47-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 06-16-2008; 12-27-2007
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

a) The disclosure is objected to because of the following informalities: The print is illegible at the bottom of pgs. 2, 8, 10, 14 and 16.

Appropriate correction is required.

The Applicants' remarks submitted with the Amendment filed on June 20, 2008 are noted, but the objection is maintained because this application may be kicked back to the examiner by the Patent Printers to correct this matter after a Notice of Allowance has been issued. It is suggested that the Applicants submit a formal substitute specification to correct the informalities in the specification.

Allowable Subject Matter

The Applicants' claims have not been rejected under either 35USC102 or 35USC103 because the Applicants' independent claims are limited to a catalyst comprising palladium supported on a support material and at least one base metal promoter **associated with** the palladium, wherein said at least one base metal promoter comprises at least one reducible oxide. EP 0 341 832 A2 does not teach that the base metal promoter is associated with the palladium on the support. Rather, EP 0

341 832 A1 teaches the passage of the exhaust gas through a platinum group metal catalyst and then passage of the exhaust gas through a **downstream** base metal catalyst (please see pg. 2 ln. 52 to pg. 3 ln. 4). Further, the Applicants have offered some surprising results for their invention in the form of a 132 Declaration signed by Mr. Raj Rao Rajaram on June 20, 2008. For example, the Declarant on paragraph no. 9 in the 132 Declaration urges that Domesle (i. e. U. S. Pat. 5,157,007) shows that the inclusion of V_2O_5 (a base metal) on a Pt:Pd or Pd-only catalyst has no promotion effect for T_{50} CO conversion in its Tables 1, 2 and 3. The Attorney urged that the Applicants have found that the inclusion of at least one base metal (i. e. a reducible oxide, for example MnO_2) actually promotes the oxidation of CO by palladium (see Example 6 in the instant specification and pg. pg. 11 or 13, 2nd full paragraph in the Attorney's Remarks). This is surprising in view of the general teachings of the prior art noted in the 132 Declaration.

In conclusion, the failure of the prior art (especially, EP 0 341 832 A1) to teach the limitations of the Applicants' independent claims, and also the showing of unexpected and surprising advantages for the Applicants' invention set forth in the Declaration signed by Mr. Raj Rao Rajaram on June 20, 2008 support the allowability of the instant claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9, 11, 12, 14-17, 22-24, 28, 33-35, 40, 44 and 47-58 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 13-21, 25, 30-34 and 36-47 of copending Application No. 10-527,634.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of both 10-527,633 and 10-527,634 describe the same apparatus and process, comprising:

a diesel engine;

a means for controlling the operating mode of the diesel engine; and

an engine exhaust system comprising a catalyst containing a platinum group metal and a base metal.

The difference between the claims of 10-527,633 and the claims of 10-527,634 is that the claims of 10-527,634 sets forth that the catalyst is a NO oxidation catalyst, *however* it is submitted that this difference would have been obvious to one of ordinary skill in the art at the time the invention was made *because* it is submitted that the same catalyst will inherently exhibit the same properties such as the claimed NO oxidation, and such recognition of inherent properties present the prior art is *prima facie* obvious: please note the discussion of the *In re Wiseman* 596 F.2d 1019, 201 USPQ 658 (CCPA 1979) court decision set forth in section 2145(II) in the MPEP.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMOTHY C. VANOY whose telephone number is (571)272-8158. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Timothy C Vanoy
Primary Examiner
Art Unit 1793

tcv

/Timothy C Vanoy/
Primary Examiner, Art Unit 1793